

REMARKS/ARGUMENTS

Claims 59-150 are now pending.

Claims 1-58 have been cancelled, without prejudice or disclaimer.

The Amendment also contains minor changes of a clerical nature. No "new matter" has been added by the Amendment.

The 35 U.S.C. § 102(a) Rejection

Claims 59-67, 69-75, 77-84, 86-92, 94-107, 109-121, 123-135, and 137-149 stand rejected under 35 U.S.C. § 102(a) as being anticipated by "Java Card™ Virtual Machine Specification: Java Card Version 2.1 Draft 2a (hereinafter "Draft 2a").¹ This rejection is respectfully traversed.

Regarding the Applicant's arguments in a response to the previous office action (dated July 16, 2003), the Examiner states:

Applicants remarked that the reference used in the previous action, i.e. Draft 2a, is dated January 29, 1999, but that it is not the date of publication (Appl. Remarks, pg. 3) because such reference was made available only after Feb. 2, 1999, the application filing date, and that the reference was an improper reference. Examiner likes to point out that in order for the rejection to be overcome, the Applicants are required to prove that *first, the reference is not published as explicitly printed on the front of the document 'Draft 2a'; and second, it is an internal document proprietary only to the group working with the Applicants*, i.e. such document and the application being co-owned by the inventor(s). The provisions as specified in the MPEP state that only an affidavit under 37 CFR 1.131 and/or 37 CFR 1.132 would enable the rejection as applied in

¹ Office Action dated November 19, 2003, ¶ 3.

the action to be overcome. The statements by Applicant's representative as presented in the response are deemed to be not in the correct format; and until such affidavits are filed appropriately, the rejection as used still applies.

Applicants also stated that the reference has been incorporated by reference in the specifications (App1. Remarks, pg. 3, bottom, pg. 4, top). The fact that a reference is included in the invention's disclosure as being incorporated by reference does not preclude the fact that such reference is published prior to the invention and owned by a different inventive entity as well, hence does not rule out its being a valid prior art for use in a corresponding type of rejection. The Applicants are required to submit an affidavit according 37 CFR 1.131 and/or 37 CFR 1.132 as indicated above because as presented in the response, the arguments are not deemed to be in proper format for consideration.²

The Applicants respectfully submit that Draft 2a is not a proper reference for a rejection under 35 U.S.C. § 102(a). Submitted with this paper are a Declarations under 37 C.F.R. 1.132 executed by Tanjore Ravishankar and co-inventor Judith Schwabe, attesting that

- (1) Draft 2a was not published on the date printed on the front of the document; and
- (2) as of February 2, 1999, Draft 2a was an internal document proprietary to Sun Microsystems, Inc.

For the above reasons, the rejection of claims 59-67, 69-75, 77-84, 86-92, 94-107, 109-121, 123-135, and 137-149 under 35 U.S.C. 102(a) is improper and should be withdrawn.

² Office Action ¶ 6 (emphasis added).

The 35 U.S.C. § 103(a) Rejection

Claims 68, 76, 85, 93, 108, 122, 136, and 150 stand rejected under 35 U.S.C. § 103(a) as obvious over Draft 2a in view of Wilkinson et al.³⁴ Claims 68, 76, 85, 93, 108, 122, 136, and 150 depend from independent claims 59, 69, 77, 87, 95, 109, and 123, respectively. As mentioned above, Draft 2a is invalid as a reference under 35 U.S.C. 102(a). For the same reasons, Draft 2a is unavailable as a reference under 35 U.S.C. 103(a). Accordingly, the 35 U.S.C. 103(a) rejection with respect to claims 68, 76, 85, 93, 108, 122, 136, and 150 is improper and should be withdrawn.

In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.

Request for Allowance

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

³ USP 6,308,317.

⁴ Office Action ¶ 4.

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-1698.

Respectfully submitted,
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